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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pinnacle Bancorp., Inc.

Serial No. 76022950

Jill Robb Ackerman and Victoria H. Finley of Baird, Holm, McEachen, Pedersen, Hamann & Strasheim LLP for Pinnacle Bancorp, Inc.

Robert Clark, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

Before Seeherman, Quinn and Hohein, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Pinnacle Bancorp. Inc. has appealed from the final refusal of the Trademark Examining Attorney to register PINN BANK 24-HOUR ONLINE BANKING and design, as shown below, with the words "BANK" and "24-HOUR ONLINE BANKING" disclaimed, for "mortgage lending services and mortgage

banking services offered to corporate and individual consumers via a global computer information network."¹



Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark, when used on its identified goods, so resembles the mark PINN PRO, previously registered for "financial services, namely, providing cash management accounts,"² as to be likely to cause confusion or mistake or deception.

Applicant and the Examining Attorney have filed appeal briefs.³ An oral hearing was not requested.

¹ Application Serial No. 76022950, filed April 11, 2000, asserting first use and first use in commerce on January 2, 2000.

² Registration No. 2309164, issued January 18, 2000.

³ In its appeal brief applicant makes reference to Internet search results that it allegedly attached to its response to an Office action. No such search results appear in the file, and applicant has confirmed to the Board, in a telephone conversation, that such documents were never submitted.

With its appeal brief applicant has submitted a copy of a definition of "cash management account," taken from the Dictionary of Banking by Jerry M. Rosenberg (1993), and has asked that we take judicial notice of it. The definition provided in this dictionary is "a bank-type development of Merrill Lynch in partnership with Bank One of Ohio, based in Columbus, where affluent clients are offered a Visa credit card and checking to

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In*

draw against their investment balances. The account was initially offered in 206 of Merrill Lynch's 382 offices in the United States." The Examining Attorney has objected, contending that because the dictionary was published ten years ago (now eleven), it does not accurately reflect the meaning of the term in the banking industry. In particular, the Examining Attorney states that "the banking dictionary may provide one archaic meaning of 'cash management account' and omit other more current meanings. The meaning of 'cash management account' provided by the banking dictionary is obviously not pertinent to registrant's services since the registrant would not be offering the services of Merrill Lynch, Bank One of Ohio and Visa."

The Examining Attorney's objection is well taken. Although "cash management account" may at one time have referred to a financial offering by Merrill Lynch, see *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987), in which the Court found that CASH MANAGEMENT ACCOUNT was not a generic term for the financial services of "stock brokerage services, administration of money market fund services, and providing loans against securities services," the registration for this mark for these services has since been cancelled pursuant to Section 8, and the U.S. Patent and Trademark Office obviously considers the phrase to be a generic term at this point, as shown by its use as an identification of the registrant's services.

re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

With respect to the services, it is well established that the goods or services of the parties need not be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See In re International Telephone & Telephone Corp., 197 USPQ 910, 911 (TTAB 1978).

In this case, both applicant and the registrant offer financial services. The Examining Attorney has made of record certain use-based third-party registrations which show that both the services identified in applicant's application and those in the cited registration are the types of services which have been registered by individual entities under a single mark.⁴ Third-party registrations

⁴ See Registration No. 2558891 for "banking, bill payment services, insurance brokerage, business brokerage, cash

which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). Moreover, these registrations show that companies may offer a range of financial and banking services under a single mark. Accordingly, consumers might well believe that applicant's identified mortgage lending services and mortgage banking services and the registrant's services of providing cash

management, commercial lending services, electronic funds transfer, financial exchange, financial guarantee and surety, financial information provided by electronic means, financing services, loan financing, security services, namely, guaranteeing loans, investment management, operating marketplaces for sellers of goods and/or services, mortgage banking, mortgage brokerage, mortgage lending, price quotations, check processing, electronic payments, namely, electronic processing and transmission of bill payment data, electronic processing of insurance claims and payment data, real estate appraisal, real estate brokerage, real estate management, leasing of real property, risk management, security services, namely, guaranteeing loans, financial guarantee and surety services, real estate syndication, guarantee assurance underwriting"; and Registration No. 2619068 for "banking services, namely, installment, commercial and real estate loans; mortgage loan services; automatic teller machine services; debit card services; credit card services; electronic fund transfers, electronic interactive banking services, namely, payment services, account balancing and fund transfer services via global computer network; trust services, namely personal and corporate investment and asset management services; insurance services, namely commercial and consumer underwriting services in property and casualty, life insurance, health insurance and annuities; cash management services; and brokerage services, namely investment brokerage, insurance brokerage, and mortgage brokerage services."

management accounts emanate from the same source if they were offered under similar marks.

We also note that applicant's services, as identified, are offered solely "via a global computer information network." However, because the registrant's services are not restricted, they may also be offered via a global computer information network. Moreover, because so many businesses today offer their goods and/or services through the Internet, including banking services as shown by the third-party registrations, and because so many consumers purchase goods and services through the Internet, consumers would be likely to come into contact with both applicant's and the registrant's services, even if one is offered through the Internet and the other is offered through more traditional means.

With respect to the marks, we find that they both share the same dominant element, PINN. The word BANK and the phrase 24-HOUR ONLINE BANKING in applicant's mark are descriptive, as applicant has acknowledged by its disclaimer thereof. Similarly, the clock design merely reinforces the significance of the descriptive phrase 24-HOUR ONLINE BANKING. The words 24-HOUR ONLINE BANKING and the clock design are clearly subordinate in size and effect to the words PINN BANK. PINN is also the dominant element

in the registered mark, since PRO is suggestive of the professional nature of the services. In articulating reasons for reaching a conclusion on the issue of the likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Here, it is the arbitrary word PINN⁵ that consumers will look to as the primary source-indicating element, and therefore it is this element, which is identical in both marks, which deserves the greater weight in our analysis. Although consumers will note the differences in appearance and pronunciation between applicant's mark and the cited mark, they will not ascribe these differences to differences in the source of the services. Rather, they will assume that one mark is a variant of the other, with each identifying services coming from a single source.

Applicant points out that financial services such as those rendered by applicant and the registrant are not

⁵ Interestingly, it appears that both applicant's and the registrant's marks are derived from "Pinnacle"; applicant is Pinnacle Bancorp, Inc. and the registrant is Pinnacle Banc Group, Inc.

impulse purchases, a statement with which we agree. However, we cannot accept applicant's statement that potential customers for these services would "affirmatively determine the identity of the service provider." Brief, p. 7. Applicant is, in effect, saying that consumers will go behind the trademarks to determine the source of the services. However, we must consider the trademarks in our determination of likelihood of confusion, not whether consumers will be confused if they ignore the trademarks. Because of the similarity of the marks, we find that even careful consumers are likely to be confused; further, relatively sophisticated members of the general public, who would be more aware of the breadth of banking services, are likely to assume that applicant's and the registrant's identified services emanate from the same source when offered under these similar marks.

Decision: The refusal of registration is affirmed.